UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,339	07/18/2003	Alexander B. Beaman	APL1P283/P3109	3294

22434   7590   07/13/2007

BEYER WEAVER LLP
P.O. BOX 70250
OAKLAND, CA 94612-0250

EXAMINER
THERIAULT, STEVEN B

ART UNIT	PAPER NUMBER
2179	

MAIL DATE	DELIVERY MODE
07/13/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>20 February 2007</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-32</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>4/18, 5/20</u>.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to the following communications: Amendment filed 02/20/2007

2.   Claims 1 -32 are pending in the case. Claims 1, 8, 16, 17, 20, 21, and 26 are the independent

claims. The applicant is advised that a new examiner has been assigned to the case.

Claim Rejections - 35 USC § 102

3.   **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the**

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   **Claims 1-2, 4, 8-29 are rejected under 35 U.S.C 102(e) as being anticipated by Born et al.**

(hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003.

In regard to **Independent claim 1,** Born teaches a method for providing an audio menu,

comprising:

- Providing text strings on a server, each text string capable of representing a menu choice

    (See Born Para 015) Born teaches the menu is provided to the device as a textual

    description.

- Generating audio files, each audio file representing a voiced name of one of the text

    strings (See Para 015) Born teaches the textual description is saved as an audio prompt.

- Associating each of the audio files with the text string corresponding thereto (See Para

    016) Born teaches there are different prompts for sections of the menu.

- Delivering the audio files to a client from the server (See Para 015). Born teaches the

    audio prompt is delivered from the server.

- Presenting a menu on the client that includes menu choices represented by the text strings, the menu choices being capable of being highlighted or selected (See Para 019) Born teaches presenting the menu to the user where the menu is described textually by the server and were the audio is played when the user selects it.

- Playing the audio file on the client when the associated menu choice is highlighted (See Para 0038 and 0050) User select items from the menu and the menu items are played

With respect to **dependent claim 2,** Born teaches the method further comprising providing a remote control that can navigate through the menu on the client (Born Para 0036). Born teaches a microphone and speakers and other wireless audio controls that can manipulate the menus.

With respect to **dependent claim 4,** Born teaches the method wherein: the client is capable of playing music; and playing the audio file when music is playing does not stop the music from playing (See Para 0077) Born teaches the music is muted but not stopped from playing.

In regard to **Independent claim 8,** Born teaches a method for creating audio menu components, wherein the audio menu components represent navigational components directed to the selection of media content, comprising:

- Providing a text string that represents a menu component, whereby the menu component is one of several options that can be selected from a displayed menu on a client device (See Born Para 015) Born teaches the menu is provided to the device as a textual description and the menu comprises more then one choice.

- Generating an audio file that is an audio representation of the menu component; delivering the audio file to a client device (See Para 015) Born teaches the textual description is saved as an audio prompt.

With respect to **dependent claim 9,** Born teaches the method further comprising: playing the audio file; and requesting approval of the played audio file prior to delivering the audio file to a client device (See Para 0049 and 0050).

With respect to **dependent claim 10,** Born teaches the method wherein generating the audio file is accomplished via a text-to-speech algorithm (See Para 0054).

With respect to **dependent claim 11,** Born teaches the method wherein

if approval is not given, providing an opportunity to modify the text string; and

if the text string is modified, replacing the audio file with a new audio file generated from the modified text string, playing the audio file, and requesting approval of the played audio file (See Para 0057 and 0058) User provides approval to add a new component and then the server generates a new audio file and it is sent to the device.

With respect to **dependent claim 12,** Born teaches the method wherein

if the text string is not modified, providing an opportunity to replace the audio file with a new audio file generated from an audio recording (See Para 0056 and 0057).

With respect to **dependent claim 13,** Born teaches the method wherein the audio file generation includes at least compression of the audio file (See Para 0054).

With respect to **dependent claim 14,** Born teaches the method wherein the delivery of the audio files includes embedding the audio files in metadata (See Para 0038).

With respect to **dependent claim 15,** Born teaches the method further comprising determining whether the audio file is present on the client device; wherein, delivering the audio files is performed only if the audio file is not present on the client device (See Figure 2) The system contains its own media database that would play a song if the audio is on the device.

In regard to **Independent claim 16,** Born teaches a server comprising:

- A processor; and memory, operably connected with the processor (See Figure 3) CPU and memory in a server 304, 318 and 102.

- Wherein the processor is operable to perform instructions including providing a text string that represents a menu component, <u>wherein the audio menu components represent navigational components directed to the selection of media content</u> (See Para 0050-0054). Born teaches a text string is generated at the server as a menu component and is sent back to the device (See also Para 0018).

- Generating an audio file that is an audio representation of the menu component; delivering the audio files to a client device (See Para 0047 and 0050-0054) Born generates an audio file for each menu component and sends the audio file to the device.

In regard to **Independent claim 17,** Born teaches a method of using audio files in a menu comprising:

- Receiving an audio file that is an audio representation of a menu component, whereby the menu component is one of several options that is selectable from the menu (See Para 0047) Born teaches an audio file accompanies a menu component where the audio file is an audible description of the menu component that is played once the user selects the menu item (See also Para 0070).

- Playing the audio file when the menu component is chosen (See Para 0049) Born teaches the audio is played once selected.

With respect to **dependent claim 18,** Born teaches the method wherein: the menu includes menu components that have not been received; and pre-packaged audio files are associated with the menu components that have not been received (See Para 0047) Born teaches the new components are added to the media database along with the new textual descriptions of the items.

With respect to **dependent claim 19,** Born teaches the method wherein

the audio file is played only after the menu component has been highlighted for a predetermined

period of time (See Para 0072 and 0074) System waits for user input

In regard to **Independent claim 20,** Born teaches a client device comprising:

- A processor; and a memory, operably connected with the processor (See Figure 2, 204,
  210 and 108).

- Wherein the processor is operable to perform instructions including receiving an audio file
  that is an audio representation of a menu component, wherein the audio menu
  components represent navigational components directed to the selection of media
  content (See Para 0015-0019 and 0038 and 0050-0054) Born teaches the processor
  receives audio files from the server where the audio file is a menu component and the
  menu can be navigated by the user on the device.

- Updating the menu to include the menu component playing the audio file when the menu
  component is chosen (See Para 0054) Born teaches adding a menu component and
  updating the media database with the new component and where the audio representing
  the menu is played once selected.

In regard to **Independent claim 21,** Born teaches a media management system comprising:

- A media database that stores media files (See Figure 2, Media Database). Born shows
  the database in memory and the media player that manages the media items in the
  database (See Para 0014-0016)

- Media collection records that include data relating to groupings of the media files (See
  Para 0038). The database contains an index the media files that are organized.
  media records that include metadata relating to the media files

- A voiced names database that stores audio files (See Figure 2, 240)

- Association records that associate the audio files with data from the media collection
  records and metadata from the media records (See Para 0038) Born teaches the

metadata ID tag for a given audio file is stored in the indexed database and recognized

once selected from the menu.

With respect to **dependent claim 22,** Born teaches the media management system wherein

the media management system is executed on a portable digital music player (See Para

0014).

With respect to **dependent claim 23,** Born teaches the method wherein the audio file is

received from a server (See Para 0015).

With respect to **dependent claim 24,** Born teaches the method wherein the menu

component is highlighted when chosen (See Para 0050).

With respect to **dependent claim 25,** Born teaches the method wherein said method further

comprises: updating the menu to include the menu component (See Para 0054).

In regard to **Independent claim 26,** Born teaches a client device comprising:

- a processor a memory, operatively connected with the processor, the memory storing

  media content and metadata for a plurality of media items, the memory also storing audio

  content representing associated with the metadata for the media items (See figure 2)

  Born teaches a memory and a processor that comprises not only a media database but

  also storage for the metadata attached to the audio content (See Para 0079).

- wherein the processor is operable to perform instructions including receiving a selection

  of one of the media items and then playing the audio content for at least a portion of the

  metadata representing associated with the selected one of the media items (See Para

  0050-0054 and 0079). Born teaches the operating system uses the ID tag within the

  metadata tag to determine the media to play. The specific tag is in relation to the menu

  selection made by the user to play the given audio item.

With respect to **dependent claim 27,** Born teaches the client device wherein the processor is

further operable to perform instructions including playing the media content for the selected one

of the media items concurrently with the playing the audio content for at least the portion of the

metadata associated with the selected one of the media items (See Para 0077) Certain actions

may interrupt but others may not. A muted content is still playing in the background for the audio

prompt actions.

With respect to **dependent claim 28,** Born teaches the client device wherein the processor is

further operable to: present a menu on the client that includes menu choices represented by the

text strings, the menu choices being capable of being highlighted or selected; and

play the audio file on the client when the associated menu choice is highlighted (See Para 0015-

0019).

With respect to **dependent claim 29,** Born teaches the client device wherein the processor is

further operable receiving instructions from a remote control to navigate through the menu (See

Para 0036).

Claim Rejections - 35 USC § 103

5.   **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness**

rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

This application currently names joint inventors. In considering patentability of the claims under

35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was

commonly owned at the time any inventions covered therein were made absent any evidence to

the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor

and invention dates of each claim that was not commonly owned at the time a later invention was

made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35

U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Born et al.
(hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003 in view of
Gallenson et al (hereinafter Gallenson) WO 01/30046 International Publication Date 26 April
2001.**

With respect to **dependent claim 3,** as indicated in the above discussion, Born teaches each
element of claim 1.

Born does not expressly teach the method wherein the voiced names are in a language other
than English.

However, this limitation would have been obvious to one of ordinary skill in the art at the time of

the invention, in view of Gallenson, because Gallenson teaches a streaming content system that

can deliver audio content to a device where the device can determine from the users profile the

dialect and language of the user and adapt the system to match the content to the user (See

page 17, lines 1-12). Gallenson and Born are analogous art because they both provide access to

content through a menu system in a portable device. The skilled artisan having the teachings of

Gallenson and Born in front of them, would determine from the suggestions in Gallenson to that

the system of Born could be modified to provide content to users in different languages because

the system tracks users selections and modifies the content appropriately (See page 15, middle)

to meet the users needs.

7. **Claims 5-7 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Born et al. (hereinafter Born) U.S. Publication 2005/0045373 published May 27, 2003 in view of Swanson et al (hereinafter Swanson) U.S. Publication 20020013784 published Jan. 2002.**

With respect to **dependent claims 5-7 and 30-32,** as indicated in the above discussion, Born teaches each element of claims 4 and 26.

Born does teach a headset with left and right attachments (See figure 2) and an audio prompt mechanism that provides a mechanism for audio to be heard via a channel.

Born does not expressly teach *the method wherein the client produces audio output in at least two channels; and the audio file is output through only one channel and wherein exactly two channels are used for the client's audio output, the two channels being a left channel and a right channel and wherein the audio file is mixed with the music when the music is playing.*

However, Swanson teaches a system that allows for a audio player complete with voice menu prompts to play audio files where there are multiple channels of the device and audio is sent over one channel and the user can interact with the device on another (Such as speaking to the device while the music is playing) (See Para 0063-0069). Swanson also teaches mixing the audio file while the music is playing (See Para 0090).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention, having the teachings of Swanson and Born in front of them, to modify the system of Born to include the multiple channels to play audio and a mechanism to mix the audio file menus while the user is listening to the music. The motivation to combine Swanson with Born comes from the suggestion in Swanson to store and playback audio files on a device where the playback allows for the music to be played and continue to be played even though a user receives an email (See Para 0031). Further, Swanson teaches that the circuitry associated with playing the audio files is used with synthesized voice commands that control the operations of the headset and therefore providing the messages when the music is still playing giving them the option to answer it or not (See Para 0039).

Response to Arguments

Applicant's arguments, see page 7, filed 02/20/2007, with respect to the rejection(s) of claim(s) 1-27 under Quershey have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Born and Born in view of Swanson and Gallenson.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. Theriault whose telephone number is (571) 272-5867. The examiner can normally be reached on M, W, F 10:00AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SBT

WEILUN LO
SUPERVISORY PATENT EXAMINER